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MV

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 09/582,623 | 07/21/00 | CHIOCCA | R 193618US3XPC |

022850 PM82/0713
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| EXAMINER | |
|---|---|
| BEHREND, H | |
| **ART UNIT** | **PAPER NUMBER** |
| 3641 | 10 |

**DATE MAILED:** 07/13/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

| Application No. | Applicant(s) |
|---|---|
| 09/582623 | Chiocca et al |
| **Examiner** | **Group Art Unit** |
| Behrend | 3641 |

*—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

☒ Responsive to communication(s) filed on 5/3/01.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

**Disposition of Claims**

☒ Claim(s) 17-32 is/are pending in the application.

Of the above claim(s) 22-30 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 17-21, 31, 32 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been ☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

**Attachment(s)**

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

**Office Action Summary**

1. Applicants election with traverse in the 5/3/01 response of species II and D is acknowledged.

The election of species requirement has been reviewed but is still deemed proper.

In an election of species requirement, the examiner is not required to show a separate status in the art or separate classification (e.g. see MPEP 808.01(a)).

It is noted that applicant has not traversed on the ground that the species are patentably distinct. If applicant will admit on the record that the species within each grouping are obvious variants of one another, the election of species requirement for that particular grouping will be withdrawn (note the first full paragraph on page 3 of the 4/3/01 Office action).

To search all species would present an undue burden because of the widely divergent nature of the various species requiring different searches.

Applicant states that claims 17-21, 27, 29, 31, 32 read on each of the elected species.

The examiner does not agree.

Claim 27 is dependent on claim 25, however, claim 25 is specific to non-elected specie C.

Claim 29 is dependent on claim 27 which (as pointed out above), is dependent on non-elected specie C. It appears that claim 29 may be an improper attempt to combine two separate species into some form of undisclosed new specie.

Claims 27 and 29 are thus also withdrawn as being drawn to non-elected species and, an action on claims 17-21, 31, 32 follows.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 17-21, 31, 32 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by either Yoshizawa et al (I) or Yoshizawa et al (II).

5. Claims 17-21, 31, 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by any of Sappey (I), Sappey (II) or France 2388377.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 17-21, 31, 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague, indefinite and incomplete.

There is no proper antecedent basis for all terms present in the claims. Examples thereof are: "one of its surfaces", "the mobile structure", "the fuel assembly", "the assembly", "the accessible end", "the compartment wall", "an adjustment device", "a control device", etc.

8. The other references cited further illustrate pertinent art.

9. Any inquiry concerning this communication should be directed to Mr. Behrend at telephone number (703) 305-1831.

Behrend/cw
July 2, 2001
July 10, 2001

HARVEY E. BEHREND
PRIMARY EXAMINER